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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,456	11/06/2003	Steven Walak	12013/47701	8550

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EXAMINER	
VORTMAN, ANATOLY	
ART UNIT	PAPER NUMBER
2835	

MAIL DATE	DELIVERY MODE
04/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/701,456	Applicant(s) WALAK, STEVEN	
	Examiner Anatoly Vortman	Art Unit 2835	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 March 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

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Primary Examiner
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Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's arguments are not persuasive. In particular, Applicant contends that "combination of Zadno-Azizi with Yoon is not suggested by the references and could only be made through impermissible hindsight using Applicant's invention as a guide". In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. In re McLaughlin, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971). In this particular case, the teaching of "finger portions" has been taken not from applicant's disclosure, but from Yoon reference. Further, the straightforward concept of finger portions for grasping the tissue have been well within the knowledge of a person of ordinary skill in the relevant art at the time of the invention. Therefore, the combination of references was not based on impermissible hindsight as alleged by Applicant.

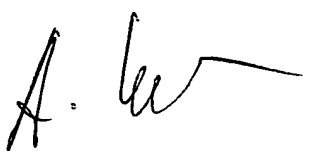
Further, Applicant has provided an extensive discussion regarding the assumption that "Zadno-Azizi does not provide any suggestion for replacing the handle-actuation of Yoon with Applicant's two-way actuation [...] the reference explicitly states that the composite material is for purpose that is wholly inapplicable to the Yoon device [...] modifying Yoon in the manner suggested by the Office Action is improper". It is not clear why Applicant discussing the modification of the Yoon device, since the device which was modified is the Zadno-Azizi's device, not the Yoon's. Yoon was used as a secondary reference for it's teaching of "finger portions" to modify the Zadno-Azizi device by introducing said "finger portions".

Further, the test for combining references is what the combination of disclosures taken as a whole (emphasis added) would suggest (emphasis added) to one of ordinary skill in the art. *In re McLaughlin,* 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest (emphasis added) to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA) 1969.

Further, it is well settled that "[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences (emphasis added) which one skilled in the art would reasonably be expected to draw therefrom." *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). "The test for an implicit showing (emphasis added) is what the combined teachings, knowledge of one of ordinary skill in the art , and the nature of the problem to be solved as a whole (emphasis added) would have suggested (emphasis added) to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1338, 1342-44, 61 USPQ2d 1430. The court also rejected the notion that "an express written motivation to combine must appear in prior art references...." . *In Ruiz v. A.B. Chance Co.,* 357 F.3d at 1276, 69 USPQ2d at 1690. Further, for obviousness under 35 U.S.C. 103, all that is required is a reasonable expectation (emphasis added) of success (of combination). *In re Longi*, 759 F.2d 887, 897, 225 USPQ 645, 651-652 (Fed. Cir. 1985); *In re Clinton*, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or **in the knowledge generally available to one of ordinary skill in the art** (MPEP 2143.01).

In the instant case the straightforward idea of Yoon of using finger portions for grasping the tissue, taken as a whole, would definitely; have suggested to a person of ordinary skill in the relevant art at the time of the invention to modify the Zadno-Azizi device by providing it with said "finger portions" so as to accommodate the device of Zadno-Azizi for a particular application, in which grasping of tissue is required.

In view of the above, it is the Examiner's opinion, that the combination of references was proper, therefore the rejection of the claims is hereby maintained.



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